

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 13817-005001
<p>I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.</p> <p>_____</p> <p>Date of Deposit</p> <p>_____</p> <p>Signature</p> <p>_____</p> <p>Typed or Printed Name of Person Signing Certificate</p>	Application Number 10/682,312	Filed October 8, 2003
	First Named Inventor Anthony G. Macaluso	
	Art Unit 2617	Examiner Michael T. Vu
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record (Reg. No.) 59,747</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> </div> <div style="width: 45%; text-align: right;"> <p>_____ /Hwa C Lee/</p> <p>_____ Signature</p> <p>_____ Hwa C. Lee</p> <p>_____ Typed or printed name</p> <p>_____ (858) 678-5070</p> <p>_____ Telephone number</p> <p>_____ May 8, 2008</p> <p>_____ Date</p> </div> </div> <p style="font-size: small; margin-top: 20px;">NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below'.</p>		
<input checked="" type="checkbox"/> Total of 3 forms are submitted.		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Anthony G. Macaluso	Art Unit:	2617
Serial No.:	10/682,312	Examiner:	Michael T. Vu
Filed:	October 8, 2003	Conf. No.:	7323
Title:	OVER THE AIR PROVISIONING OF MOBILE DEVICE SETTINGS		

Mail Stop Appeal

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program and 07 February 2006 - Extension of the Pilot Pre-Appeal Brief Conference program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal and factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-4, 6-29, 32-37 and 39-41 are pending with claims 1, 16, 24 and 32 being independent. In the Office Action dated January 28, 2008, the Office rejected claims 1-4 and 6-23 under 35 U.S.C. 103(a) as allegedly being unpatentably over U.S. Patent Application Publication No. 2003/0003933 to Deshpande ("Deshpande") in view of U.S. Patent Application Publication No. 2003/0032417 to Minear ("Minear") and further in view of U.S. Patent Application No. 2003/0074660 to McCormack ("McCormack"). In addition, the Office rejected claims 24-29, 32-37 and 39-41 under 35 U.S.C. 103(a) as allegedly being unpatentable over Minear in view of Deshpande, and further in view of McCormack

REMARKS

Final Office Action of January 28, 2008 amounts to clear error for failing to present a *prima facie* case of obviousness.

Appellant respectfully submits that the Final Office Action of January 28, 2008 fails to present a *prima facie* case of obviousness required under 35 U.S.C. § 103 because the rejections are fatally flawed at least for relying on a mischaracterization of the claims. For example, the Office misreads claim 1, which recites in part, “receiving a request from the mobile device for choices of available service providers and associated mobile service subscription choices that include at least a choice of mobile calling plan.”

As described in the previous response, the present application is directed to providing a user with the ability to choose a service provider and associated mobile service subscription from the user's mobile device to initiate or modify the selected subscription. In this way, the user is not limited to a particular service provider, and the user does not need to physically go to the service provider or call the service provider in order to initiate a service subscription. The user is able to receive choices of service providers and associated service subscriptions on his/her mobile device, make the selection of at least one service provider and at least one associated subscription service, and activate the selected service subscription associated with the selected service provider from the mobile device.

The Office concedes that Deshpande and Minear fails to teach or suggest the claimed “receiving a request from the mobile device for choices of available service providers and associated mobile service subscription choices that includes at least a choice of mobile calling plan” as recited in claim 1. Then, the Office contends that McCormack remedies the deficiencies of Deshpande and Minear. However, this contention of the Office is based on a mischaracterization of claim 1 and thus amounts to clear error by the Office.

In particular, the Office contends that “McCormack teaches to the field of portable electronic devices and networked electronic communication includes a wireless cellular phone system provides different subscribers with different calling plans specifically selected by the subscriber.” (Office Action Dated January 28, 2008.) However, it is unclear how this general teaching of McCormack is relevant to the recited features of claim 1.

For example, McCormack describes nothing about how the subscriber is able to select the calling plan. The cited portions of McCormack merely describe the well-known fact that different cellular phone subscribers can have different calling plans. (See, McCormack at ¶ [0005].) As known to those in the art, one subscriber can have an unlimited calling plan with unlimited talk-time while another subscriber can have a limited calling plan with a limited talk-time, for example.

Moreover, McCormack fails to teach or suggest whether the calling plan in McCormack is associated with the claimed choices of available service providers. This is not surprising because McCormack merely teaches allowing different subscribers to select different calling plans. McCormack does not teach or suggest that each subscriber can request choices of service providers with associated service subscriptions as recited in claim 1.

Thus, the Office seems to suggest, in error, that claim 1 merely claims allowing the user to select his own plan. However, as described above, claim 1 recites in part “receiving a request from the mobile device for choices of available service providers and associated mobile service subscription choices that include at least a choice of mobile calling plan.” Thus, the claimed request for choices of available service providers must be received from the mobile device. Further, the claimed request received from the mobile device must include request for choices of available service providers and the associated mobile service subscription choices that include at least the choice of mobile calling plan. The Office has failed to show that these features are taught or suggested by McCormack or other cited prior art, either alone or in combination.

Then, the Office erroneously reasons that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Deshpande/Minear, such that at least a choice of mobile calling plan is selected by a user to provide the flexibility of users desired to select a calling plan in different environments such [as] downloading from the server to the wireless devices via the wireless network.” (See Office Action Dated January 28, 2008 at page 4.) This is nonsensical reasoning by the Office because the system in Deshpande is not equipped to provide the claimed choice of mobile calling plan and the system in Minear requires a preexisting calling plan for the mobile device before a user can download the software applications.

For example, Deshpande discloses using a mobile device to scan for wireless network access points or “hot spots.” (*See, e.g.,* Deshpande at ¶ [0008], lines 1-23.) This wireless network in Deshpande is limited to providing network access services. The system in Deshpande simply does not offer at least a choice of mobile calling plan because the described hot spots are not designed to provide calling plan options.

Minear is directed to a system for the “deletion and reloading of software application components on a wireless device.” (*See* Minear at ¶ [0023], ll. 1-4.) The system in Minear deletes and reloads the software application components to provide an “efficient usage of the wireless device system resources such that the user can have ready access to a larger amount of executable software applications that can be completely stored on the wireless device.” (*See* Minear at ¶ [0016], ll. 11-19. *Emphasis added.*) These software applications of Minear fail to provide choices that include at least a choice of mobile calling plan as recited in claim 1.

A user of the wireless device in Minear would reasonably have had to purchase a qualifying mobile service subscription including a calling plan, from *an already selected wireless service provider* that allows the wireless device to access the internet or other resources *before* a desired software application can be downloaded. Because the choice of a subscription in Minear presumably already has been made (otherwise, the wireless device would not be authorized to download any software applications) before receiving the selected phone, the user cannot send a request from the phone for choices of service providers and associated subscription choices or receive the choices of service providers and associated subscription choices on the mobile device to enable wireless communications over a wireless network, as recited in claim 1.

Thus, even assuming *arguendo*, that Deshpande, Minear and McCormack could somehow be combined, which is not conceded, the hypothetical combination still would fail to teach each and every feature of claim 1. Namely, the proposed combination fails to teach or suggest the claimed, “receiving a request from the mobile device for choices of available service providers and associated mobile service subscription choices that include at least a choice of mobile calling plan.” (*Emphasis added.*) For at least these reasons, claim 1 is allowable over the proposed combination of Deshpande, Minear and McCormack.

Claims 2-4 and 6-15 depend from claim 1 and are allowable for at least the same reason. Independent claim 16 is allowable for at least reasons similar to claim 1. Claims 17-23 depend from claim 15 and are allowable for at least the same reason.

Independent claim 24 is allowable over the proposed combination of Minear, Deshpande and McCormack for at least reasons similar to claim 1. Claims 23-29 depend from claim 24 and are allowable for at least the same reasons. Independent claim 32 is allowable for at least reasons similar to claim 24. Claims 33-37 and 39-41 depend from claim 32 and are allowable for at least the same reasons.

CONCLUSION

The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence with other positions of the Examiner that have not been explicitly contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

Please apply the fees for one-month extension of time, Notice of Appeal, and Pre-Appeal Brief and any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: May 8, 2008

/Hwa C. Lee/

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